

REMARKS

Claims 1-3, 6-9, 11, 13-17, 19 and 21-25 are pending in the application, claims 4, 5, 10, 12, 18 and 20 being canceled herein, and claims 23-25 being new.

Objection to the Disclosure

In the Office Action, the Examiner objected to the disclosure for containing an embedded hyperlink. The specification has been carefully reviewed, and the single occurrence of a hyperlink, found in the Background of the Invention section, has been removed by amendment made herein.

It is respectfully requested that the objection now be withdrawn.

Objections to Claims 5-9

The Examiner objected to claims 5-9 for a noted informality, requesting that the phrase –the steps of—be inserted into the preamble thereof.

The original application contained claims 1-22, not claims 1-14 as indicated by the Examiner in the Office Action Summary form. It appears that the Examiner may have erroneously examined a set of claims contained at the end of the specification attached to the DECLARATION filed on June 14, 2004, filed in response to a Notice to File Missing Parts mailed from the USPTO on March 12, 2004. The Specification of the present application does not contain a claim 5 with language “comprising” as believed by the Examiner.

It is respectfully requested that the objection be withdrawn.

Double Patenting

Claims 1-14 were rejected under 35 USC 101 as allegedly claiming the same invention as that of claims 1-14 of prior U.S. Pat. No. 6,658,260.

As indicated above, it appears that the Examiner has examined the wrong set of claims 1-14 that were attached to the Declaration attaching the original specification, not claims 1-22 as originally filed herein.

It is respectfully requested that the rejection be withdrawn.

Terminal Disclaimer

To expedite the prosecution of the present application, a Terminal Disclaimer is attached hereto which disclaims any terminal portion of a patent issuing hereon extending beyond the full statutory life of US Pat. No. 6,658,260.

IDS Documents

The Applicants respectfully request the Examiner's explicit indication that he has fully considered all cited references, including the US Patents listed on the Information Disclosure Statement filed on April 7, 2005 (before the date of the Office Action).

Full consideration is requested of all references cited in that IDS.

Swear Behind Bennett Publication

In the parent patent, during its prosecution, all claims were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Pat. No. 6,230,009 to Holmes et al. ("Holmes") in view of U.S. Pat. Publ. No. 2002/0112104 to Bennett et al. ("the Bennett Publication").

Attached hereto is a Declaration Under 37 C.F.R. 1.131 that swears behind the Bennett Publication, removing it as prior art.

In particular, in the Rule 131 declaration, the inventor declares, and attaches documentation evidencing, conception of the present invention at least as early as April 6, 2001. This conception date predates the filing date of the application underlying the Bennett Publication. Thus, the Bennett Publication is not prior art with respect to the claims of this application (or the parent USP 6,658,260).

Acknowledgement of the Rule 131 Declaration, and the immateriality of the Bennett Publication with respect to the invention, is respectfully requested.

Non-cited Bennett Provisional Application

The Bennett Publication is a publication of an underlying patent application (which is not an issued patent). The underlying patent application claims priority from U.S. Provisional Patent Application 60/225,603 filed on August 15, 2000 (“the Bennett Provisional Application”).

The Bennett Provisional Application is not a published document, and therefore is not itself prior art with respect to the present application (or its parent).

The patent application underlying the Bennett Publication makes a claim of priority for subject matter claimed therein from U.S. Provisional Application No. 60/225,603 (“Bennett Provisional Application”), filed nearly a year before the application underlying the Bennett Publication, on August 15, 2000. Nevertheless, like the Bennett Provisional Application, neither should the Bennett Publication be properly considered prior art to the Invention.

In particular, as shown in the attached Declaration of Chris Knotts, the present invention was conceived at least as early as April 6, 2001. The regular patent application underlying the Bennett Publication was not filed until August 2, 2001, and not published until August 15, 2002. Thus, the Bennett Publication is not prior art under §§102(a) or (b) because it was not known or used by others or patented or described in a patented publication before the Invention and was not patented or described in a printed publication more than one year before the Application was filed on November 1, 2001 or the provisional application was filed on September 5, 2001.

For the Bennett Provisional Application to be considered prior art under 35 U.S.C. §§ 102(a) or 102(b), it must have been publicly known, used or published. Oddzon Products, Inc. v. Just Toys, Inc., 122 F.3d 1396, 1401-03 (Fed. Cir. 1997). The Bennett Provisional Application itself, however, is not published, § 122(b)(2)(A)(iii). Thus, the Bennett Provisional Application is not prior art under §§ 102(a) or (b), and in fact has never been cited as a prior art reference in the ‘260 Patent.

As for §102(e)(1), there apparently is no legal precedent guiding a determination of whether a regular application for patent is deemed for purposes

of use as a § 102 reference, to have been filed on the filing date of a related provisional application, which is not itself an application for patent. This is particularly poignant in the present application because the provisional application is a different document than the regular application which claims priority therefrom, and the teachings of each document as a prior art reference should be taken in the context of that particular document only.

It is respectfully submitted that reading the teachings of a later filed regular application, and affording it an earlier publication/filing date, for its use as a prior art reference, would be improper. Teachings of the Bennett Provisional Application should be taken in the context of that disclosure, not imported piecemeal into the Bennett Publication, which is a different document.

Accordingly, the Bennett Provisional Application is not prior art under §102(e) because it is not an “application for patent” filed before the invention. A reference must generally be public before being considered prior art, Oddzon Products, 122 F.3d at 1402. A provisional patent application is neither an “application for patent”, nor published, § 122(b)(2)(A)(iii). Thus, there is no legal support justifying giving a published application the benefit of the date of an earlier filed (and different) provisional application’s filing date, for the purposes of its use as a § 102 reference.

Even if the application underlying the Bennett Publication is deemed to have been filed as of the date of the Bennett Provisional Application and therefore somehow renders the Bennett Publication to be prior art as of the date of the earlier filed Bennett Provisional Application, Holmes and the Bennett Publication, either individually or in combination, still do not teach or suggest the invention.

For instance, Holmes appears to disclose a mobile station that can be selectively coupled to two or more networks (Holmes, Abstract). Holmes teaches that by maintaining an address translation table and introducing communication between switching control units within multiple networks, it is possible to provide notification to the mobile station of the existence of a communication request from a first network while the mobile station is coupled to the second network (Holmes, col. 2, line 59-col. 3, line 38). Holmes fails to

disclose or suggest an inter-carrier messaging module to receive a digital message packet addressed with only a phone number, as recited by claims 1-3, 6-9, 11, 13-17, 19, 21 and 22.


Similarly, the Bennett Publication appears to disclose techniques for facilitating communication among a plurality of different telecommunications systems (Bennett Publication, Abstract). In the Bennett Publication, routing address information derived from the intended recipient's phone number is clearly **added to the message address before the message is ever sent**. (See, e.g., the Bennett Publication, Fig 5 and p. 11, ¶ 0132 through p. 12, ¶ 0137.) Thus, the Bennett Publication also fails to teach or suggest an inter-carrier message module to receive a digital message addressed with only a phone number, as recited by claims 1-3, 6-9, 11, 13-17, 19, 21 and 22.

Lastly, as explained above, the Bennett Provisional Application is not prior art to the Invention. Even if one assumes, however, that the Bennett Provisional Application should be considered prior art, like the Bennett Publication, the Bennett Provisional Application clearly discloses the **addition of routing information** to the recipient's phone number before the message is ever sent. (See, e.g., the Bennett Provisional Application § 7.3). Therefore, the Bennett Provisional Application also fails to teach or suggest an inter-carrier message module to receive a digital message addressed with only a phone number, as recited by claims 1-3, 6-9, 11, 13-17, 19, 21 and 22.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'William H. Bollman', written over a horizontal line.

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